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13  
 14 UNITED STATES DISTRICT COURT  
 15 NORTHERN DISTRICT OF CALIFORNIA

16 ROGER SCHLAFLY,

17 Plaintiff,

18 v.

19 PUBLIC KEY PARTNERS AND RSA DATA  
 20 SECURITY, INC.,

21 Defendants,

22 RSA DATA SECURITY, INC.,

23 Plaintiff,

24 v.

25 CYLINK CORPORATION and CARO-KANN  
 26 CORPORATION, et al.

27 Defendants.

No. C-94-20512 SW

No. C-96-20094 SW

**DEFENDANTS' MOTION FOR  
 SUMMARY JUDGMENT ON THE  
 VALIDITY OF THE DIFFIE-  
 HELLMAN PATENT**

Date: September 4, 1996  
 Time: 10:00 a.m.  
 Courtroom: 4

Hon. Spencer Williams

28  
 DEFENDANTS' SUMMARY JUDGMENT MOTION:  
 DIFFIE-HELLMAN PATENT VALIDITY  
 C-96-20094 SW

**FILED****JUL 31 1996**

RICHARD W. WIEKING  
 CLERK, U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 SAN JOSE

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Please take notice that on September 4, 1996, at 10:00 a.m. or as soon thereafter as the matter may be heard, defendants and counter-claimants Cylink Corporation ("Cylink"), Caro-Kann Corporation ("Caro-Kann"), and The Board of Trustees of the Leland Stanford Junior University ("Stanford") (collectively "defendants") will move, and hereby do move, for summary judgment that RSA Data Security, Inc. ("RSADSI") cannot prove by clear and convincing evidence that any of the claims of U.S. Patent No. 4,200,770 (the "Diffie-Hellman Patent") are invalid.

## MEMORANDUM OF POINTS AND AUTHORITIES

## Introduction

The sole argument RSADSI has specifically articulated to contest the validity of the Diffie-Hellman patent is that the inventors violated the "printed publication" bar of 35 U.S.C. § 102(b) by disseminating their inventions through oral presentations and prepublication review by colleagues. Although the Court has previously stated that this assertion raised serious questions, under controlling law, an invention is invalid only if, more than one year prior to filing a patent application, it is generally available in a printed form to anyone interested in the field. RSADSI cannot prove that in this case.

To support its argument, RSADSI points to two separate activities by the inventors. First, RSASDI points out that there were three oral presentations with slides made by the inventors more than one year before the date of the patent application. However, as RSADSI's counsel acknowledged at the preliminary injunction hearing, there is no legal precedent for applying the publication

# DIFFIE-HELLMAN PATENT VALIDITY

1 bar based on an oral disclosure -- the statute prohibits just  
 2 "printed publications." Second, RSADSI points out that the  
 3 inventors circulated drafts of a paper to several colleagues, who,  
 4 as the inventors expected, treated the drafts as confidential. Even  
 5 accepting all of the facts alleged by RSADSI as true, RSADSI's  
 6 evidence is insufficient under the controlling law to prove by clear  
 7 and convincing evidence that there was a printed publication,  
 8 generally accessible to anyone interested in the field. Therefore,  
 9 defendants are entitled to summary judgment on RSADSI's invalidity  
 10 allegations.<sup>1</sup>

11 Because RSADSI cannot raise a genuine issue of material fact,  
 12 summary judgment should be entered against all of RSADSI's claims  
 13 and defenses that are based upon an allegation that the Diffie-  
 14 Hellman Patent claims are invalid.

#### 15 Background Facts

16 The Diffie-Hellman Patent relates to advances in cryptography.  
 17 It was filed with the United States Patent Office on September 6,  
 18 1977 and granted on April 29, 1980. [Exh. 1] Before the Diffie-  
 19 Hellman inventions, all secret code schemes used a single "key" to  
 20 encode and decode a message. [Id., 1:22-29] Under such systems,  
 21 parties wishing to communicate over an insecure channel needed to

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22  
 23 <sup>1</sup> Invalidity under 35 U.S.C. § 102(b) "is a question of law to  
 24 be determined based upon underlying factual determinations."  
 25 Eiselstein v. Frank, 52 F.3d 1035, 1038 (Fed. Cir. 1995). In this  
 26 motion, defendants contend that even accepting all facts, and  
 27 drawing all inferences in favor of RSADSI, RSADSI cannot establish  
 28 clear and convincing evidence sufficient to meet its legal burden.  
 In fact, however, RSADSI's evidence and the inferences to be drawn  
 from that evidence are and will be disputed. [See, e.g., Hellman  
 Decl. and Exh. 10 hereto (Diffie Depo.)] Consequently, if the Court  
 denies defendants' motion, any doubt as to the facts relating to  
 RSADSI's "printed publication" defense must be left to the jury to  
 resolve.

1 find a way to exchange the secret key before a coded message could  
2 be sent. [Id.] The exchange of a secret key, however, was always a  
3 weakness, since anyone who intercepted the key could decode the  
4 secret message. [Id.]

5 The Diffie-Hellman patent covers what has been called "Diffie-  
6 Hellman Public Key Agreement." [See, e.g., Exh. 2 at 52 (RSADSI's  
7 BSAFE User's Manual, Version 2.1)] As RSADSI admits, "Whitfield  
8 Diffie and Martin Hellman invented this, the first true public-key  
9 algorithm, in 1976." [Id.] With this invention, parties can  
10 exchange two different numbers over an insecure channel from which a  
11 shared, secret key can be calculated by both. [Exh. 1, 2:7-22] An  
12 eavesdropper who obtains either or both numbers exchanged publically  
13 over the insecure channel would nonetheless be unable to determine  
14 the secret key. [Id.] The invention revolutionized cryptographic  
15 systems by eliminating the security weakness of prior, single  
16 exchanged key systems. [Id.] Thus, unlike all prior cryptography  
17 developed over thousands of years, parties using the Diffie-Hellman  
18 method can be completely indifferent to the actions of enemy  
19 eavesdroppers -- even if the enemy has all the information  
20 exchanged, the message cannot be decoded.

21 Parts of the Diffie-Hellman invention were disclosed in a paper  
22 entitled "New Directions in Cryptography." [Exh. 1 at 1; Exh. 3]  
23 The "New Directions" paper was published in the IEEE journal  
24 Transactions in Information Theory, in November 1976, 10 months  
25 before the patent application was filed. [Id.]

26 Defendant Caro-Kann now holds exclusive sublicensing rights to  
27 the Diffie-Hellman Patent. [Exh. 4, at 4-5] At one time, however,  
28 RSADSI was a general partner in Public Key Partners ("PKP"), which

1 held exclusive sublicensing rights in the Diffie-Hellman Patent.  
 2 [Exh. 5] As a general partner in PKP, RSADSI approved and actively  
 3 pursued an infringement action against TRW, alleging in a Complaint  
 4 filed in this Court that the Diffie-Hellman patent "was duly and  
 5 lawfully issued." [Exhs. 6 ¶ 8 and 7 (PKP Arb. Testimony at 243-  
 6 246)] As a general partner in PKP, RSADSI asserted the validity of  
 7 the Diffie-Hellman Patent in license negotiations in order to  
 8 extract payments from third parties. [Exh 8] Even today, after PKP  
 9 was dissolved and RSADSI filed this very action to invalidate the  
 10 patents, RSADSI continues to tout that its software products include  
 11 the "patented Diffie-Hellman Public Key Exchange." [Exh. 9] Thus,  
 12 RSADSI has repeatedly acknowledged and relied upon the validity of  
 13 the Diffie-Hellman Patent. Finally, no party, including RSADSI, has  
 14 ever cited any prior art of other inventors alleged to anticipate or  
 15 render obvious the Diffie-Hellman inventions.

#### 16 ARGUMENT

#### 17 I. SUMMARY JUDGMENT SHOULD BE GRANTED WHEN, AS A MATTER OF 18 LAW, THE CHALLENGER CANNOT PROVE BY CLEAR AND CONVINCING EVIDENCE THAT THE PATENT CLAIMS ARE INVALID.

19 The Diffie-Hellman Patent claims are presumed to be valid as a  
 20 matter of law. 35 U.S.C. § 282. To overcome this presumption,  
 21 RSADSI carries the burden of proving by clear and convincing  
 22 evidence that the claims are invalid. See, e.g., American Hoist &  
 23 Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1360 (Fed. Cir.),  
 24 cert. denied, 469 U.S. 821 (1984). The presumption shifts "the  
 25 burden of going forward as well as the burden of proof of facts to  
 26 the challenger." Avia Group Int'l, Inc. v. L.A. Gear California,  
 27 853 F.2d 1557, 1562 (Fed. Cir. 1988) (affirming summary judgment  
 28 that defendant failed to prove patent invalidity).

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Summary judgment should be granted if there are no genuinely disputed issues of material fact. Fed. R. Civ. P. 56. Because RSADSI carries the burden of proving that the patent claims are invalid, RSADSI's failure to raise a genuine issue of material fact in opposition to this motion requires entry of summary judgment in favor of the defendants. Celotex Corp. v. Catrett, 477 U.S. 317, 322-23, 106 S.Ct. 2548, 2552-53, 91 L.Ed. 265 (1986).<sup>2</sup>

"[A] nonmovant must do more than merely raise some doubt as to the existence of a fact; evidence must be forthcoming from the nonmovant which would be sufficient to require submission to the jury of the dispute over the fact." Avia Group, 853 F.2d at 1560. "If the evidence [of the nonmovant] is merely colorable, or is not significantly probative, summary judgment may be granted." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249-50, 106 S.Ct. 2505, 2511, 91 L.Ed.2d 202 (1986). Here, RSADSI's evidence falls short.

## II. RSADSI CANNOT CARRY ITS BURDEN OF PROVING INVALIDITY.

The only invalidity defense to the Diffie-Hellman patent that RSADSI has ever specifically articulated is a Section 102(b) defense. Under 35 U.S.C. § 102(b), a patent claim may be invalidated if the claimed invention was "described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States." A document, to serve as a printed publication, must be "generally available." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 936 (Fed. Cir.), cert. denied, 498 U.S. 920 (1990).

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<sup>2</sup> Because a patent is presumed valid, the patentee has "no obligation to introduce any evidence initially on validity." Avia Group, 853 F.2d at 1562.

In its opposition to defendants' motion for preliminary injunction, two of RSADSI's witnesses declared that the inventors had presented material relating to the "New Directions" paper at a conference. [Exh. 12 (Ingemarrsen Decl. ¶¶ 4,8); Exh. 13 (Konnheim Decl. ¶¶ 4-5)]. Two of RSADSI's witnesses testified that they had obtained a draft of the inventors' paper more than one year prior to the date of the patent application, and that they kept these drafts confidential as the inventors understood they would. [Exh. 14 (Blatman Decl. ¶¶ 3-4); Exh. 12 (Ingemarrsen Decl. ¶ 3); see also Hellman Decl. ¶ 2, 4]<sup>3</sup> Even assuming it is all true and undisputed, such testimony is not sufficient to satisfy the requirements of the printed publication bar under 35 U.S.C. § 102(b).

**A. An Oral Presentation, Even Accompanied by Slides, Is Not a "Printed Publication" Under Section 102(b).**

Section 102(b) bars disclosure of an invention in a "printed publication" more than one year prior to filing a patent application. Under the express language of the statute an oral presentation of the invention is not prohibited in the least.<sup>4</sup> As RSADSI's counsel candidly admitted at the hearing on the preliminary injunction, there is no legal precedent for imposing a statutory bar

<sup>3</sup> A third declarant, Professor Konnheim, cannot even remember when he got the draft and thus provides no evidence that he received the paper before the statutory bar date.

<sup>4</sup> Indeed, the Patent Office granted the patent claims after review of a patent office record that disclosed that the "New Directions" paper had been presented at a conference more than one year prior to the date of the application. The cover of the "New Directions" paper, which was a part of the record in the patent examination, discloses that "portions of this work were presented at the IEEE Information Theory Workshop, Lenox, MA, June 23-25, 1975 and the IEEE International Symposium on Information Theory in Ronneby, Sweden, June 21-24, 1976." [Exh. 3]

1 based on the inventor's oral disclosures. [Exh. 11 at 66:16-18 ("I  
 2 do not contend that the law says that mere oral presentations are  
 3 alone sufficient")] Thus, conference presentations, speeches and  
 4 slide shows about an invention cannot violate the restrictions of  
 5 102(b). Regents of the Univ. of California v. Howmedica, Inc., 530  
 6 F. Supp. 846, 860 (D.N.J. 1981), aff'd without op., 676 F.2d 687 (3d  
 7 Cir. 1982).

8 The Howmedica case is directly on point. In Howmedica, the  
 9 inventors of an artificial knee presented a lecture and slides to at  
 10 least thirty persons at a conference of the California Medical  
 11 Association. 530 F. Supp. at 849-850. The slides showed pictures  
 12 and drawings of the inventions, including the essential elements of  
 13 the patent claims. Id. at 850. However, there were no written  
 14 descriptions of the invention available at the lecture, and the  
 15 public did not have access to the slides themselves. Id. The Court  
 16 held that there had been no printed publication, reasoning that:

17 the projection of the slides at the lecture was  
 18 limited in duration and could not disclose the  
 19 invention to the extent necessary to enable a  
 20 person of ordinary skill in the art to make or  
 21 use the invention. In this regard, it is  
 22 important to note that the public did not have  
 23 access to the slides prior to the critical date,  
 24 and that no prints of the slides were made prior  
 25 to said date. Therefore, there is no evidence  
 26 that the "publication" was disseminated or  
 27 otherwise made available to the extent that  
 28 persons interested in the information could  
 locate it and put to use the essentials of the  
 claimed invention.

25 Id. at 860.

26 The facts here, even according to the witnesses presented by  
 27 RSADSI in opposition to defendants' motion for preliminary  
 28

injunction, are virtually identical to the facts in Howmedica. Although RSADSI's declarants claim to have seen a slideshow with transparencies, neither one requested or received copies of transparencies. [Exh. 13 (Konheim Decl. ¶ 5); Exh. 12 (Ingemarsson Decl. ¶¶ 5, 9)]. The inventors did not make the slides available during or after the presentations. [Hellman Decl. ¶ 3; Exh. 10 (Diffie Depo. at 47:2-7)]. As in Howmedica there is no evidence that the inventors made a printed copy of their paper available at any of the presentations.<sup>5</sup> [Exh. 14 (Blatman Decl. ¶ 6); Hellman Decl. ¶ 3; Exh. 10 (Diffie Depo. at 45:25-46-3; 82:10-11)]. As in Howmedica, these facts cannot establish a "printed publication."

**B. Restricted Distribution of Drafts Cannot Constitute a "Printed Publication" Under Section 102(b).**

To establish that an August draft of the "New Directions" paper was a "printed publication," RSADSI must show by clear and convincing evidence that it was "generally available" such that "anyone could have had access to the documents by the exercise of reasonable diligence." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 936-37 (Fed. Cir.), cert. denied, 498 U.S. 920 (1990) (distribution of 50 copies of a paper did not constitute publication when it was distributed under the understanding that copies would not be disseminated and where members of public did not have direct access to the document). In considering whether a document

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<sup>5</sup> These facts clearly distinguish this case from Massachusetts Institute of Technology v. AB Fortia, 774 F.2d 1104 (Fed. Cir. 1985), the only case on which RSADSI relies. In Fortia, the invention was not only presented orally at a conference, the inventors (1) announced that a final paper existed that disclosed the invention and (2) distributed the paper at the conference "without restriction." 774 F.2d at 1109.

1 constitutes a publication under 35 U.S.C. 102(b), "the touchstone is  
2 public accessibility." In re Bayer, 568 F.2d 1357, 1359 (C.C.P.A.  
3 1978); see also Aluminum Co. of America v. Reynolds Metals Co., 14  
4 U.S.P.Q.2d 1170, 1172-73 (N.D. Ill. 1989). "Limited distribution .  
5 . . even to those skilled in the art, does not amount to  
6 'publication' under the statute unless the material is otherwise so  
7 situated that 'anyone who chooses may avail himself of the  
8 information it contains.'" Solarex Corp. v. Arco Solar, Inc., 121  
9 F.R.D. 163, 176 (E.D.N.Y. 1988), aff'd, 870 F.2d 642 (Fed. Cir.  
10 1989) (citations omitted).

11 Accordingly, it has long been recognized that limited  
12 circulation of a printed paper to friends or colleagues for  
13 their review is not a "publication." Preemption Devices,  
14 Inc. v. Minnesota Min. & Mfg. Co., 732 F.2d 903, 906 (Fed. Cir.  
15 1984) (dissemination of six copies of brochure to a friend was  
16 not "publication" under § 102(b)); Bayer, 568 F.2d at 1361  
17 (dissemination of thesis to three members of dissertation  
18 committee was not a "publication" under § 102(b)); National  
19 Semiconductor Corp. v. Linear Technology Corp., 703 F. Supp.  
20 845, 848-49 (N.D. Cal. 1988) (conference articles submitted to  
21 IEEE for review was not a "publication" under § 102(b)); Ex  
22 Parte Gould, 231 U.S.P.Q. 943, 948 (Bd. Pat. App. & Int. 1986)  
23 (distribution of preprint of paper to personnel at Bell labs  
24 and elsewhere insufficient to bar patent under § 102(b));  
25 Solarex, 121 F.R.D. at 176 (referee's dissemination of paper to  
26 colleagues about the merits of the paper does not constitute a  
27 printed publication under § 102(b)).

1 A paper in restricted circulation is not a "publication"  
 2 because it is not publicly accessible. Gould, 231 U.S.P.Q. at  
 3 947-48. That is true even where, as here, the restrictions are  
 4 understood, and not explicit. Aluminum Co., 14 U.S.P.Q.2d at  
 5 1171 ("understood, even though silent, limitation on access can  
 6 be every bit as effective as an express one"); see also  
 7 National Semiconductor, 703 F.Supp. at 849 (implicit  
 8 confidentiality).

9 The evidence in this case simply does not measure up to  
 10 evidence of a printed publication under these authorities. The  
 11 inventors circulated a small number of drafts of the "New  
 12 Directions" paper to colleagues based on a recognized under-  
 13 standing that the drafts would be maintained in confidence.  
 14 [Hellman Decl. ¶ 4; Exh. 14 (Blatman Decl. ¶¶ 3-4)]<sup>6</sup> RSADSI  
 15 presents no evidence to the contrary.

16 Although RSADSI's first declarant, Mr. Blatman, confirmed  
 17 that he received a copy of a draft of the "New Directions"  
 18 before the critical date, he testified that

19 It was my practice not to distribute papers  
 20 received from a colleague without first  
 21 obtaining the author's permission. In this  
 22 case, I never asked Mr. Diffie for his  
 23 permission to further distribute the August  
 24 Paper. I have never given a copy of the August  
 25 Paper to anyone else.

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26 <sup>6</sup> Blatman, who says that he received a copy of the paper  
 27 unsolicited, was a close colleague of Diffie's, with whom Diffie had  
 28 previously shared draft papers. [Exh. 10 (Diffie Dep. at 26:24-  
 27:18)]

[Exh. 14 (Blatman Decl. ¶¶ 3-4)] Compare Aluminum Co., 14 U.S.P.Q.2d at 1172-73 (no evidence that any of the 33 recipients of paper gave away a copy or shared its contents).

RSADSI's second declarant, Mr. Ingemarsson, declared that he received a copy of a draft paper in his capacity as an IEEE reviewer. [Exh. 12 (Ingemarsson Decl. ¶¶ 3, 8)] In this capacity, he was indisputably obligated to keep the paper confidential. See National Semiconductor, 703 F. Supp. at 848-49.

RSADSI's third declarant, Professor Konheim (also RSADSI's paid expert), could not recall when he received a copy of the draft paper. [Exh. 13 (Konheim Decl. ¶ 7)]. His declaration provides no evidence whatsoever that there was a publication before the critical date, only that there "could have" been. As the Court recognized in Aluminum Co., such evidence is insufficient to shoulder the burden of proving publication by clear and convincing evidence:

Even when all genuine disputes are resolved in Reynolds' favor, as they must be on ALCOA's motion, Reynolds' proof comes up short. . . . [T]he best evidence Reynolds has produced suggests only that the letter might have been accessible. . . . More importantly, however, the relevant question is not what "could have" been done, but what actually was done. Even if the "could have" statements are credited, they do not prove Reynolds' case.

14 U.S.P.Q.2d at 1173 (emphasis in original).

RSADSI's best evidence, gleaned after months of investigation, is insufficient as a matter of well-established law to prove the inventions were disclosed in a printed publication before the critical date. RSADSI's counsel conceded as much at

1 the preliminary injunction hearing, admitting that RSADSI's  
2 argument requires at least "an extension of district court  
3 cases." [Exh. 11 at 28:14-15] In fact, RSADSI's argument is  
4 not an "extension" of the existing law, it is contrary to it.  
5 The authorities explicitly permit oral presentations and  
6 restricted circulation of draft papers to colleagues. These  
7 acts do not constitute a "printed publication" and cannot  
8 invalidate the patent claims.

#### 9 CONCLUSION

10 The law governing this Court's examination of the 102(b)  
11 defense that RSADSI raises is unambiguous: to be a "printed  
12 publication" the invention must be described in a printed form that  
13 is generally available to the audience of interested persons.  
14 RSADSI has acknowledged that its best evidence would require the  
15 Court to change the express statutory language and ignore precedents  
16 to prohibit actions that the current law allows. This Court must  
17 reject this invitation, and rule that RSADSI's evidence is  
18 insufficient to defeat summary judgment.

19 RSADSI cannot point to any genuine issue of material fact to  
20 support any of its allegations that the Diffie-Hellman patent claims  
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1 are invalid. Summary judgment should be entered against all of  
2 RSADSI's claims and defenses based upon those allegations.

3 Dated: July 31, 1996

4 MORRISON & FOERSTER LLP  
5 ALSTON & BIRD

6  
7 By: 

Karl J. Kramer

8 Attorneys for Defendants/  
9 Counter-Claimants CYLINK  
10 CORPORATION, CARO-KANN  
11 CORPORATION and STANFORD  
12 UNIVERSITY  
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